

REMARKS

By this Amendment, claims 9, 13, 15, 18, 19, 20 and 21 are amended. Accordingly, claims 1-10, 12-16, 18-22, and 24-37 are pending in this application. No new matter is added. Reconsideration of the application is respectfully requested.

Entry of the amendments is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested.

I. The Claims Satisfy All Formal Requirements

The Office Action objects to claims 18 and 19 because claims 18 and 19 depend from cancelled claim 17. In the paragraph bridging pages 9-10 of the December 15, 2003 Amendment, Applicant asserted that claims 18 and 19 depended from claim 15. Accordingly, Applicant has amended claims 18 and 19 to depend from independent claim 15 to correct the typographical errors and to obviate the objection. Withdrawal of the objection of claims 18-19 is respectfully requested.

In addition, Applicant has amended claims 9 and 13 to correct typographical errors and improve form.

II. The Claims Define Allowable Subject Matter

The Office Action rejects claims 1-10, 12-16, 18-22, 24-29, and 31-37 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,605,120 to Fields et al. ("Fields") in view of U.S. Patent No. 6,301,586 to Yang et al. ("Yang"). This rejection is respectfully traversed.

Fields and Yang, taken separately or in combination, do not disclose, teach or suggest "a displayed document, which is displayed by an accessing device," as recited in independent claim 1, and from which claims 2-10 and 12-14 depend.

Fields and Yang, taken separately or in combination, also do not disclose, teach or suggest "selecting the injectable content displayed by the accessing device," as recited in claim 1.

Fields and Yang, taken separately or in combination, also do not disclose, teach or suggest "outputting to an output device the downloadable information identified by the injectable content without routing data contained in the downloadable information through the accessing device," as recited in independent claim 1.

Fields and Yang taken separately, or in combination, do not disclose, teach or suggest displaying "the injectable content in the document, which is displayed by the accessing device," as recited in claim 15, from which claims 16, 18 and 19 depend. Applicant has amended claim 15 to further clarify that "the injectable content in the document ... is displayed by the accessing device, " and that a "displayed document ... is displayed by the accessing device ..." for consistency with pending claim 1.

Further, Fields and Yang, taken separately or in combination, do not disclose, teach or suggest an "output circuit outputs the downloadable information associated with the selectable injectable content to an output device without routing data contained in the downloadable information through the accessing device, which displays the document," as recited in claim 15.

Examples of an accessing device which displays a document include a computer and personal digital assistant. A computer or personal digital assistant 100 is described on page 6, lines 3-8 of the specification.

As indicated on page 1, lines 22-25 of the specification, systems download information into the memory portion of a computer or a personal digital assistant that is being used to access the downloadable information. Because the downloadable information may contain very large files, the downloadable information can consume a great deal of storage space on the user's computer or personal digital assistant, and can unnecessarily slow down the user's computer or personal digital assistant while the downloadable information is being downloaded or compiled into a job.

Accordingly, in exemplary embodiments of the present invention, an accessing device, such as a personal digital assistant or computer, displays injectable content so that a user can select "the injectable content displayed by the accessing device," as recited in claim 1, and display "the injectable content in the document, which is displayed by the accessing device," as recited in claim 15. Subsequently, the method outputs "to an output device the downloadable information identified by the injectable content without routing data contained in the downloadable information through the accessing device," as recited in claim 1, or an "output circuit outputs the downloadable information... to an output device without routing data contained in the downloadable information through the accessing device, which displays the document," as recited in claim 15.

The Office Action asserts that a web content server 107 of Fields is an "accessing device" as recited in claims 1 and 15. However, Applicant respectfully submits that the web content server 107 of Fields is not an accessing device, as recited in claim 1, because the web server 107 does not display injectable content. Therefore, Fields does not disclose, teach or suggest "selecting the injectable content displayed by the accessing device," as recited in claim 1 and displaying "the injectable content in the document, which is displayed by the accessing device," as recited in claim 15.

Because Fields does not disclose, teach or suggest such "an accessing device," Fields cannot "output" to an output device the downloadable information without routing data contained in the downloadable information through the accessing device.

Yang does not overcome the deficiencies of Fields. Yang discloses a system for managing multimedia objects to provide an electronic picture album. The system organizes multimedia objects into a collection of albums to be printed or displayed.

Yang does not disclose the "accessing device" as recited in claims 1 and 15.

Fields and Yang, taken separately or in combination, do not disclose, teach or suggest "a display window... , wherein the downloadable information contains data, which is not routed through the accessing device, which displays the graphical user interface," as recited in claim 20.

Applicant has amended claim 20 to further clarify that the accessing device displays the graphical user interface for the sake of consistency with the foregoing.

The Office Action concedes that Fields does not explicitly teach a graphical user interface. Instead, the Office Action asserts that Yang discloses a graphical user interface in Figure 15. However, neither Yang nor Fields teach, disclose or suggest a graphical user interface displayed by the alleged "accessing device" 107. Accordingly, withdrawal of this rejection is respectfully requested.

Fields and Yang, taken separately or in combination, do not disclose, teach or suggest, "downloadable information contains data, which is not routed through the computer device, which displays the document," as recited in claim 21, and from which claims 22, 24-37 directly or indirectly depend.

The Office Action implies that the web content server 107 is the same as the "computer device" recited in claim 21. However, as discussed above, the web content server 107 of Fields does not display a document. Because Fields does not disclose, teach or suggest

a computer device displaying a document, Fields cannot avoid routing data contained in downloadable information through such a computing device.

Yang does not overcome the deficiencies Fields. Yang discloses a system for managing multimedia objects to provide an electronic picture album. The system organizes multimedia objects into a collection of albums to be printed or displayed.

Yang does not disclose the "downloadable information contains data, which is not routed through the computer device, which displays the document" as recited in claim 21.

In view of the foregoing, withdrawal of this rejection of claims 1-10, 12-16, 18-22, 24-29 and 31-37 is respectfully requested.

The Office Action rejects claim 30 under 35 U.S.C. §103(a) as unpatentable over Fields in view of Yang and further in view of U.S. Patent No. 6,618,163 to Roosen et al. ("Roosen"). This rejection is respectfully traversed.

Because claim 30 depends from claim 21 and Roosen does not overcome the deficiencies of Yang and Fields discussed above, withdrawal of this rejection is respectfully requested for the same reasons discussed above.

For at least these reasons, it is respectfully submitted that independent claims 1, 15, 20 and 21 are patentably distinguishable over the applied references. The remainder of the claims that depend from independent claims 1, 15, 20 and 21 are likewise patentably distinguishable over the applied references for at least the reasons discussed above, as well as for the additional features they recite.

III. Conclusion

For at least these reasons, it is respectfully submitted that the application in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-10, 12-16, 18-22, and 24-37 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Paul F. Daebeler
Registration No. 35,852

JAO:PFD/can

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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